

## **REMARKS**

### ***Claim Amendments***

Prior to examination, Applicants respectfully requests entry of the above amendment to the claims and submits that the above amendments do not constitute new matter. The amendment to claim 42 made herein was to clarify the elements of the kit of claim 42. Support for the amendment to the claims can be found, *inter alia*, throughout the specification and in the claims as originally filed, in particular, at Examples 9 and 22.

### ***Response to Restriction Requirement***

The Office Action required restriction to one of Groups I or II which are purportedly distinct inventions under 35 U.S.C. § 121. The Office Action requires that Applicants elect of one of two (2) allegedly distinct inventions.

Applicants hereby provisionally elect **Group I** (claims 1-3, 6-10, and 34-35), drawn to, according to the Office Action, methods for genotyping, **with traverse**, and respectfully request reconsideration of the restriction requirement in view of the following remarks. Applicants moreover reserve the right to file divisional application(s) directed to non-elected subject matter.

Applicants respectfully urge that the Restriction Requirement is improper, as it does not establish that searching for both inventions would constitute an undue burden on the USPTO. Accordingly, Applicants submit that the Restriction Requirement is improper and should be withdrawn.

According to the MPEP, when claims can be examined together without undue burden, the USPTO must examine the claims on the merits even though they are directed to independent and distinct inventions. MPEP § 803. In establishing that an “undue burden” would exist for co-examination of claims, the USPTO must show that examination of the claims would involve substantially different prior art searches, making the co-examination burdensome. To show undue burden resulting from searching difficulties, the USPTO must show that the restricted groups have a separate classification, acquired a separate status in the art, or that searching would require different fields of search. MPEP § 808.02. Therefore, restriction between inventions is only proper when a search burden exists for the Examiner to search all the

inventions claimed. If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinct inventions. MPEP § 803.01.

Applicants submit that it would not constitute an undue burden to examine the inventions of Groups I and II together because they are co-extensive in subject matter, all being directed to differentiating animals and animal products on the basis of breed origin; determining or testing the breed origin of an animal product; or validating an animal product by distinguishing between different alleles of breed determinant genes. The search within each of Groups I and II would overlap because a search of a method for a method based on distinguishing alleles of breed-determining genes for differentiating animals and animal products on the basis of breed origin; determining or testing the breed origin of an animal product; or validating an animal product would necessarily be conducted in the same field of search as reagents essential for distinguishing such alleles in a kit for practicing such a method. Therefore a search of either of the Groups would overlap with the other Group and it would not constitute an undue burden to search Groups I and II together.

Applicants further submit that it would not constitute an undue burden to examine the inventions of Groups I and II together because they do not constitute a separate status in the art. Group I is a method which uses the product of Groups II. Therefore, any search of a method of a method for differentiating animals and animal products on the basis of breed origin; determining or testing the breed origin of an animal product; or validating an animal product would occur in the same field of search as the kit of Group II. Accordingly, it would not constitute an undue burden to search Groups I and II together.

In view of the above remarks, Applicants respectfully request that the Restriction Requirement be withdrawn and that all claims be prosecuted in the same patent application. In the event that the requirement is made final and in order to comply with 37 C.F.R. § 1.143, Applicants reaffirm the election with **traverse of Group I** (claims 1-3, 6-10, and 34-35), holding claim 42 in abeyance under the provisions of 37 C.F.R. § 1.142(b) until final disposition of the elected claims.

**CONCLUSION**

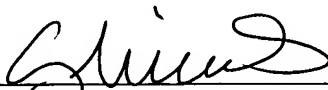
Applicants maintain that the restriction requirement is improper and that all pending claims, *i.e.*, claims 1-3, 6-10, 34-35, and 42 should be examined for patentability. If the Examiner believes that prosecution might be advanced by discussing the application with Applicants' representatives, in person or over the telephone, we would welcome the opportunity to do so.

Respectfully submitted,

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